

### **REMARKS**

The Official Action mailed October 29, 2009, has been received and its contents carefully noted. This response is filed within three months of the mailing date of the Official Action and therefore is believed to be timely without extension of time. Accordingly, the Applicant respectfully submits that this response is being timely filed.

The Applicant notes with appreciation the consideration of the Information Disclosure Statements filed on July 14, 2006; September 11, 2006; and June 25, 2009.

Claims 1-36 are pending in the present application, of which claims 1, 8, 15, 19, 23, 27, 31, 33, 35 and 36 are independent. Claims 1, 4, 8, 11, 15, 18, 19, 22, 23, 26, 27 and 30-36 have been amended to better recite the features of present invention. The Applicant notes with appreciation the indication of the allowability of claims 4, 5, 11 and 12. For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

The Official Action rejects claims 1-3, 6-10 and 13-36 as obvious based on the combination of U.S. Patent No. 6,522,549 to Kano and U.S. Publication No. 2002/0094639 to Reddy. As stated in MPEP §§ 2142-2144.04, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some reason, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some reason to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317

(Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The prior art, either alone or in combination, does not teach or suggest all the features of the independent claims, as amended. Specifically, independent claims 1 and 8 have been amended to recite that a separating sheet is configured to be peeled from an adhesive, which is supported in the present specification, for example, by paragraph [0113] of the pre-grant publication of the present application, and Figure 34A. Also, independent claims 15, 23 and 31 have been amended to recite features similar to those recited in claim 36, i.e. an insulating layer over an antenna and a wiring formed on the insulating layer, where the wiring is connected to the antenna through a contact hole formed in the insulating layer. Further, independent claims 19, 27 and 33 have been amended to recite features similar to those recited in claim 35, i.e. an internal substratum having a first surface and a second surface opposing the first surface; an antenna formed over the first surface of the internal substratum; a thin film integrated circuit device including a thin film transistor over the first surface; and a wiring formed on the second surface of the internal substratum, where the wiring is electrically connected to the thin film transistor and a part of the antenna through a contact hole formed in the internal substratum. These features are supported in the present specification, for example, by Embodiment Modes 1, 2 and 4, paragraphs [0119] and [0123]-[0125] of the pre-grant publication and Figures 1A-4A and 5A-7B. For the reasons provided below, Kano and Reddy, either alone or in combination, do not teach or suggest the above-referenced features of the present invention.

Regarding independent claims 1 and 8, the Official Action asserts that "Kano teaches ... a separating sheet (3a, 3b)" (pages 2-3, Paper No. 20091026). However, Kano does not teach or suggest a separating sheet configured to be peeled from an adhesive.

Regarding independent claims 15, 23, 31 and 36, the Official Action asserts that "Kano teaches ... an insulating layer over the antenna; a wiring formed on the insulating layer; ... the wiring is connected to the antenna through a contact hole formed in the

insulating layer" (pages 5-6, Paper No. 20091026; citing Kano at column 4, line 25, to column 5, line 26). While the cited portions of Kano, i.e. column 4, line 25, to column 5, line 26, refer to Figures 1-4, the Official Action fails to specify what portions of Kano allegedly correspond to the features of the present claims rendering the Official Action unclear and incomplete. In any event, Kano does not teach or suggest an insulating layer provided between an antenna and a wiring.

Regarding independent claims 19, 27, 33 and 35, the Official Action asserts that "Kano teaches ... a label substratum having a first surface and a second surface opposing to the first surface; an antenna ...; an integrated circuit device over the first surface of the label substratum; a wiring formed on the second surface of the label substratum; ... wherein the wiring electrically connects the integrated circuit device and a part of the antenna through a contact hole formed in the label substratum" (pages 4-5, Id.; citing column 4, line 25, to column 5, line 26). Again, the Official Action fails to specify what portions of Kano allegedly correspond to the features of the present claims rendering the Official Action unclear and incomplete. In any event, the Applicant respectfully submits that Kano teaches the following: "In the IC card 1 as shown in FIGS. 1 and 2, a full sized antenna substrate 2 is used. Then, at a predetermined position on this antenna substrate 2, an IC chip 7 is pasted via an ACF ... conductive film 6" (see column 4, lines 50-53). If one were to assert that the ACF conductive film 6 of Kano corresponds with the wiring of the present claims, then the Applicant notes that the ACF conductive film 6 appears to be on the same side of the antenna substrate 2 as an antenna and the IC chip 7 (see Figure 1 of Kano), which is inconsistent with the present claims. As such, Kano does not teach or suggest an antenna and a thin film integrated circuit device including a thin film transistor over a first surface of a substratum and a wiring formed on a second surface of the substratum.


Reddy does not cure the above-referenced deficiencies in Kano. Reddy is relied upon to allegedly teach an integrated circuit device including a thin film transistor (pages 3-6, Id.). However, Kano and Reddy, either alone or in combination, do not teach or suggest at least the above-referenced features of amended independent claims.

Since Kano and Reddy do not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

The Commissioner is hereby authorized to charge fees under 37 C.F.R. §§ 1.16, 1.17, 1.20(a), 1.20(b), 1.20(c), and 1.20(d) (except the Issue Fee) which may be required now or hereafter, or credit any overpayment to Deposit Account No. 50-2280.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

  
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